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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/799,209 | 03/12/2004 | Abraham Ebbie Soroudi | 158627-0003 | 7431 |

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| EXAMINER |
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KIDWELL, MICHELE M

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| ART UNIT | PAPER NUMBER |
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3761

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/799,209

Applicant(s)

SOROUDI, ABRAHAM EBBIE

Examiner

Michele Kidwell

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8/24/05; 9/19/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

Claim 17 is objected to because of the following informalities: the term "heat source" lacks antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 17 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an exothermic reaction, does not reasonably provide enablement for a heat source. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 4, 22 – 25 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams (US 3,804,077).

With reference to claim 1, Williams discloses a pad comprising: a multipart container (11) having an impermeable outer membrane (col. 2, lines 56 – 61) sized to fit generally within the peri-orbital region and sufficiently flexible to mold to the eye; a first chemical (19) in a first storage area in the multipart container; a second chemical (17) in a second storage area in the multipart container, the first and second chemicals selected to have an exothermic reaction when mixed (col. 2, lines 65 – 68) for producing a temperature suitable for treating eye conditions, the exothermic reaction providing the suitable temperature for a period of time suitable for treating eye conditions (col. 3, lines 19 – 22); and an inner membrane (21) for initially separating the first and second chemicals, the inner membrane being renderable permeable, without penetration of the impermeable outer membrane, to permit mixing the first and second chemicals to cause the exothermic reaction as set forth in col. 3, lines 40 – 43.

As to claims 2 and 3, Williams discloses a pad wherein the second storage area surrounds and is adjacent to the first storage area as set forth in figure 14.

With reference to claim 4, Williams discloses a pad wherein the inner membrane is breakable by application of pressure to the outside of the device as set forth in col. 1, lines 64 – 66.

As to claims 22, 23 and 30, Williams discloses a pad further comprising a handle that is attached away from the portion of the device applied to a user's peri-ocular region as set forth in figure 1A.

With reference to claims 24 – 25, see the rejection of claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 – 17 and 24 – 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farmer (WO 93/10019).

With reference to claim 1, Farmer discloses a pad comprising: a multipart container (1) having an impermeable outer membrane (page 2, 3rd paragraph) sized to fit generally within the peri-orbital region and sufficiently flexible to mold to the eye; a first chemical in a first storage area in the multipart container; a second chemical in a second storage area in the multipart container (page 1, 4th paragraph), and an inner membrane (11) for initially separating the first and second chemicals, the inner membrane being renderable permeable, without penetration of the impermeable outer membrane, to permit mixing the first and second chemicals as set forth on page 3, 3rd paragraph.

The difference between Farmer and claim 1 is the provision that the first and second chemicals are selected to have an exothermic reaction when mixed for producing a temperature suitable for treating eye conditions, the exothermic reaction

providing the suitable temperature for a period of time suitable for treating eye conditions.

Farmer teaches the use of chemicals for personal use in emergency situations.

It would have been obvious to one of ordinary skill in the art to modify the chemicals of Farmer to provide desired chemicals, such as those producing an exothermic reaction suitable for treating eye conditions, since it has been held that the substitution of one personal use chemical for another requires only a level of ordinary skill in the art.

As to claim 3, Farmer teaches a pad wherein the second storage area is adjacent to the first storage area as set forth in figure 1.

With reference to claim 4, Farmer teaches a pad wherein the inner membrane is breakable by application of pressure to the outside of the device as set forth on page 3, 3rd paragraph.

Regarding claim 5, Farmer teaches a pad further comprising: a soft material attached to at least part of the impermeable membrane, said soft material suitable for absorbing and retaining a cleansing substance suitable for cleansing the eye as set forth on page 1, 4th paragraph.

With reference to claims 6 and 7, Farmer teaches a pad further comprising: a pH controlled cleansing substance retained in or on the soft material, the cleansing substance suitable for cleansing the peri-orbital region as set forth on page 2, 2nd paragraph.

As to claims 8 and 9, Farmer teaches a pad wherein the cleansing substance is present in the soft material in breakable containers as set forth on page 1, 5th paragraph. The examiner contends that the pad of Farmer is fully capable of performing the recited function.

Regarding claims 10 and 11, Farmer teaches a pad further comprising: an antibacterial antibiotic retained in or on the soft material, the antibacterial antibiotic that may be present in a mix suitable for killing bacteria in the peri-orbital region as set forth on page 2, 2nd paragraph.

With reference to claims 12 and 13, Farmer teaches the use of an antibiotic as set forth on page 2, 2nd paragraph.

The examiner contends that where the general conditions of a claim are disclosed in the prior art, the substitution of one essential component of a device (i.e., an antibiotic) for another is within the level of ordinary skill in the art.

Regarding claims 14 – 16, Farmer teaches the use of a non-woven textiles material as set forth on page 2, 2nd paragraph.

The examiner contends that the term non-woven textiles material is broad enough to encompass the claimed limitations.

With reference to claim 17, see page 1, 4th paragraph.

As to claims 24 and 25, see the rejection of claim 1.

The difference between Farmer and claim 26 is the provision that the article further comprises a sterile wrapping.

The examiner contends that it would have been obvious to one of ordinary skill in the art to provide the article with a sterile wrapping because it is well known in the art to package personal articles in sterile wrapping in order to avoid undesirable contamination of the product prior to use.

With reference to claims 27 and 28, Farmer teaches the use of both a detergent and an antibiotic as set forth on page 2, 2nd paragraph.

The examiner contends that the material is fully capable of being pre-soaked as claimed.

Claims 18 – 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (US 3,804,077) and further in view of Igaki et al. (US 6,409,746).

The difference between Williams and claim 18 is the provision that the suitable temperature falls within a specific range.

Williams discloses the use of calcium chloride and water as suitable for use as set forth in col. 3, lines 19 – 22.

Igaki et al. teach that temperature released during an exothermic reactions relating to the eye should be 100 degrees Fahrenheit as set forth in col. 4, lines 33 – 36.

Igaki et al. also teach that the use of calcium chloride is a suitable composition to generate the desired temperature as set forth in col. 3, lines 59 – 64.

It would have been obvious to one of ordinary skill in the art to modify the temperature of Williams to provide the claimed suitable temperature because Williams

discloses the use of calcium chloride and water which generally falls within the claimed range as supported by the teaching of Igaki.

In the alternate, Igaki et al. teach that the temperature can easily be modified (col. 4, lines 49 – 51) which is within the level of skill of one of ordinary skill in the art.

With reference to claims 19 – 21, the examiner contends that based on the use of comparable materials suitable for functions comparable to those claimed as set forth in the rejection of claim 18 that the article of Williams is fully capable of performing the recited function.

Claims 26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (US 3,804,077).

The difference between Williams and claim 26 is the provision that the article further comprises a sterile wrapping.

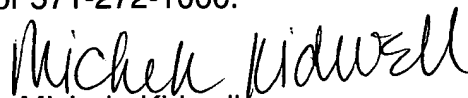
The examiner contends that it would have been obvious to one of ordinary skill in the art to provide the article with a sterile wrapping because it is well known in the art to package personal articles in sterile wrapping in order to avoid undesirable contamination of the product prior to use.

As to claim 29, the examiner contends that absent a teaching of unexpected result, the substitution of one chemical for another is within the level of ordinary skill in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Kidwell whose telephone number is 571-272-4935. The examiner can normally be reached on Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Michele Kidwell
Primary Examiner
Art Unit 3761